

**REMARKS**

Applicants have amended claims 1, 8, 9, 16, 17, and 24 as set forth above. No new matter has been added by way of these amendments. In view of the following remarks, reconsideration of the outstanding office action is respectfully requested.

Claims 1, 3, 5-6, 8-9, 11, 13-14, 16-17, 19, 21-22, 24-25, 31-33 and 39-47 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 6,778,982 to Knight et al. (Knight) in view of U.S. Patent Application Publication No. 2002/0032735 to Burnstein et al. (Burnstein), and claims 35-38 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Knight in view of Burnstein as applied to claims 1, 9, 17 and 26 as applied above, and further in view of U.S. Patent Application Publication No. 2002/0059164 to Shtivelman (Shtivelman).

Knight, Burnstein, and Shtivelman, taken alone or in combination, do not disclose or suggest, “a forum spawning device adapted to query a set consisting of users participating in the first forum when at least two of the two or more rules is satisfied, and creates a new electronic forum based on one or more replies from the set of users,” as recited by claim 1, or “querying a set consisting of users participating in the first electronic forum when at least two of the two or more rules is satisfied,” as recited by claims 9 and 17.

Knight is directed towards an online content system for creating, compiling and presenting content to subscribers, in which a subscriber interface is configured to present search, review and listing operations in an apparently flexible manner. Knight discloses an extraction robot 230 which periodically retrieves content from outside sources, such as UseNet and/or online message board systems. Knight gleans the content from community based traffic monitoring (col. 9, lines 46-50). Knight at most discloses a technique to group and/or classify user queries/postings by monitoring, so that new data clusters of interest to a community are extracted, and arranged logically on a server 220 for access by subscribers.

As correctly acknowledged by the Office, “Knight et al. fails to disclose or suggest a forum spawning device adapted to query a set of users participating in the first forum when at least two of the two or more rules is satisfied, and creates a new electronic forum based on one or more replies from the set of users and a subscriber determining device adapted to determine which of the queried users indicate interest in the new electronic forum and subscribes each interested user to the new electronic forum, but does not subscribe users of the set who do not indicate interest in the new electronic forum.” Rather, the Office relies on Burnstein to solve the deficiencies of Knight.

However, Burnstein fails to resolve the deficiencies of Knight. Burnstein's invention discloses contacting currently searching and previously searching users and asks them if they want to join a new community on the topic of the search string. However, such current and previous searching users can be part of different community/discussion forums and thus are not a set consisting of users participating in the same community/discussion forum as required by the claims. In stark contrast, the present invention is concerned with querying users that are already participating in the same first forum, and are not users who are disparately searching, as disclosed in Burnstein. Similarly, Shtivelman does not disclose or suggest a forum spawning device adapted to query a set consisting of users participating in the first forum when at least two of the two or more rules is satisfied, and creates a new electronic forum based on one or more replies from the set of users as claimed.

In view of the foregoing amendment and remarks, the Office is respectfully requested to reconsider and withdraw this rejection of claims 1, 9, and 17. Since claims 3, 5-6, 8, 31, 39, 40, and 41 depend from and contain the limitations of claim 1, claims 11, 13, 14, 16, 32, 42, 43, and 44 depend from and contain the limitations of claim 9, and claims 19, 21, 22, 24, 25, 33, 45, 46, and 47 depend from and contain the limitations of claim 17, they are distinguishable over the cited references and patentable in the same manner as claims 1, 9, and 17.

Additionally, Knight, Burnstein, and Shtivelman, taken alone or in combination, do not disclose or suggest, "wherein the information comparison is based on a rule-based model and a statistical-based model" as recited in claims 8, 16, and 24. The Office has asserted, "As per claims 8, 16 and 24, Knight et al teaches wherein an information comparison is based on at least one of a rule-based model and a statistical-based model (col. 9, lines 25-65)." However, there is simply no mention or suggestion in Knight at this cited portion or elsewhere of information comparison based on a rule-based model and a statistical-based model. Similarly, none of the other cited references teach or suggest wherein the information comparison is based on at least one of a rule-based model and a statistical-based model as required by these claims. In view of the foregoing remarks, the Office is respectfully requested to reconsider and withdraw the rejection of claims 8, 16, and 24.

Further, Knight, Burnstein, and Shtivelman, taken alone or in combination, do not disclose or suggest, "wherein the comparison is between newer email messages and older messages to determine when a new topic of conversation has begun" as recited in claims 39

and 45 and, “wherein the comparing is comparing newer email messages to older messages to determine when a new topic of conversation has begun” as recited in claim 42. The Office has asserted, “As per claims 39, 42 and 45, Knight et al in view of Burnstein et al teaches the claimed invention as described above. Furthermore, Knight et al teaches wherein the comparison is between newer email messages and older messages to determine when a new topic of conversation has begun (See col. 24, lines 52-65).” However contrary to the Office’s assertions, this portion of Knight cited to by the Office merely discloses a message retrieval/indexing system comprising a traffic monitor routine 538. This routine is generally configured to analyze user queries, commands, postings and interface settings to tabulate hot discussion areas. Based on such traffic monitoring, the monitor routine creates one or more tabulation databases 580-582 (FIG. 5b of Knight). In other words, Knight’s traffic monitoring system is merely observing the popularity of messages or queries and then storing those popular messages or queries. However, there simply is no disclosure in Knight that compares new and old messages to detect or determine when a new topic of conversation has begin. Similarly, none of the other cited references teach or suggest wherein the comparison is between newer email messages and older messages to determine when a new topic of conversation has begun as required by these claims. In view of the foregoing remarks, the Office is respectfully requested to reconsider and withdraw the rejection of claims 39, 42, and 45.

Even further, Knight, Burnstein, and Shtivelman, taken alone or in combination, do not disclose or suggest, “wherein the information monitoring device detects whether the new topic of conversation is likely to generate additional email messages” as recited in claim 40, “detecting whether the new topic of conversation is likely to generate additional email messages” as recited in claim 43, or “detecting whether the new topic of conversation is likely to generate additional email messages” as recited in claim 46. The Office has asserted, “As per claims 40, 43 and 46, Knight et al in view of Burnstein et al teaches the claimed invention as described above. Furthermore, Knight et al teaches wherein the information monitoring device detects whether the new topic of conversation is likely to generate additional messages (See col. 10, lines 5-10). However, Knight fails to teach wherein the message can be e-mail. Burnstein et al teaches wherein the input can be E-mail (see, page 8, paragraph [01001]). It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate forum spawning device that queries a set of users when at least one of the at least one rules is satisfied and creates a new forum

based on one or more replies from the set of users as taught by Burnstein et al in the claimed invention of Knight et al in order to invite the match parties to join a frictionless and immediate electronic community if they so desire (See page 1, paragraph [0013]).”

Applicants respectfully disagree with the Office’s assertions. In the cited portions, Knight discloses or suggests content extraction robots used initially by the service provider to construct a preexisting library of information which can be drawn upon when the service is first used. Prior to such a construction, Knight classifies and sorts information into a number of subject matter areas representing logical collections of content according to a set of service provider rules, filters, criteria, etc. However, such a construction of an initial content database by Knight’s system does not involve detecting whether a new topic of conversation is likely to generate additional email messages. In fact, Knight is silent with respect to any such detection of likelihood of generation of additional messages, let alone generation of additional e-mail messages. Burnstein and the other cited references also are silent with respect to this limitation of claims 40, 43, and 46, and thus do not resolve this deficiency of Knight.

In view of the foregoing amendments and remarks, the Office is respectfully requested to reconsider and withdraw the rejection of claims 40, 43, and 46.

In view of all of the foregoing, Applicants submit that this case is in condition for allowance and such allowance is earnestly solicited.

Respectfully submitted,

Date: March 24, 2009

/Gunnar G. Leinberg/  
Gunnar G. Leinberg  
Registration Number 35,584

**NIXON PEABODY LLP**  
1100 Clinton Square  
Rochester, New York 14604  
Telephone: (585) 263-1014  
Facsimile: (585) 263-1600